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09/862,845	05/21/2001	Kehyeh Szutu	SZUTU-2K03	8377

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EXAMINER

ALI, MOHAMMAD

ART UNIT

PAPER NUMBER

2177

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2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,845

Applicant(s)

SZUTU, KEHYEH

Examiner

Mohammad Ali

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. This communication is responsive to the application filed on May 21, 2001. The application has been examined. Claims 1-25 are pending in this Office Action.

Drawings

2. The drawings filed on May 21, 2001 have been approved by the Draftsperson under 37 CFR 1.84 or 1.152, see attached PTO form 948.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(e) (to a provisional application), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "The map server 120 includes a request handler 105 that can be implemented as a hypertext transfer protocol (HTTP) processor, a Simple Mail Transfer Protocol (SMTP) processor, or a telephone attendant processor", does not reasonably provide enablement for "HTTP, SMTP and a Telephone attendant processor". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to "HTTP, SMTP and a Telephone attendant processor" the invention commensurate in scope with these claims.

The Internet system of claim 12 wherein: said map request processor further comprising a map request handler for handing said map request submitted in hypertext transfer protocol (HTTP), simple mail transfer protocol (SMTP) and telephonic-tone input as said map request as recited in claim 16.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 16 "The Internet system of claim 12 wherein: said map request processor further comprising a map request handler for handing said map request submitted in hypertext transfer protocol (HTTP), simple mail transfer protocol (SMTP) and telephonic-tone input as said map request" as recites

the broad recitation "HTTP, SMTP and a Telephone attendant processor", and the claim also recites 17 which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-5, 9, 11-14, 16, and 18-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Chern et al. ('Chern' hereinafter), US Patent 6,456,854.

With respect to claim 1,

Chern teaches a method for retrieving a map from an Internet web-site (col. 7, lines 5-20) comprising:

a) sending a map request with a telephone number to said Internet web-site (depending on the display capabilities of the mobile telephone the Web server responses with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20, Fig. 2); and

b) receiving a map from said Internet web site associated with said telephone a number sent with said map request (the Web server marks the location of the mobile telephone device on the map and upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

As to claim 2,

Chern teaches wherein: said step a) of sending a map request with a telephone number comprising a step of sending said map request to a map server for processing said map request with said telephone number for obtaining an address for said telephone number (the requesting party enters the required authorization information and a unique identifier of the specific mobile device whose location is desired. The Web server responds with the street address of the mobile telephone and the time that the mobile unit reported being at that location, see co. 7, lines 10-17).

As to claim 3,

Chern teaches wherein: said step b) further comprising a step of retrieving a map of said address (a requesting party gain access to a Web server via browser residing on a mobile telephone device. Using the browser, the requesting party navigates to and selects an option for retrieving location information, see col. 7, lines 5-9).

As to claim 4,

Chern teaches wherein: said step a) of sending a map request with a telephone number comprising a step of sending said map request from a mobile phone to a map server for processing said map request with said telephone number for obtaining an address for said telephone number (the requesting party enters the required authorization information and a unique identifier of the specific mobile device whose location is desired. The Web server responds with the street address of the mobile telephone and the time that the mobile unit reported being at that location, see co. 7, lines 10-17).

As to claim 5,

Chern teaches wherein: said step a) of sending said map request from a mobile phone to a map server further comprising a step of pushing a map-retrieval key on said mobile phone for logging on to said map server (a requesting party gain access to a Web server via browser residing on a mobile telephone device. Using the browser, the requesting party navigates to and selects an option for retrieving location information, see col. 7, lines 5-9).

With respect to claim 9,

Chern teaches a method for retrieving a map from network server (see col. 7, lines 5-20) comprising:

a) sending a map request as a numeric input data to said network server (depending on the display capabilities of the mobile telephone [numeric data] the Web server responses with street address, time and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20, Fig. 2); and

b) receiving a map from said network server associated with said numeric data input sent with said map request (the Web server marks the location of the mobile telephone device on the map and upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

As to claim 11,

Chern teaches wherein: said step a) of sending a map request as numeric input data comprising a step of sending said map request from a mobile phone to a network server for processing said numeric input data for obtaining a geographic location associated with said numeric input data (the Web server sends a message to the mobile telephone device requesting the device's location. When the mobile telephone device receives the request, it responds by acquiring Global positioning system location and then sending the location to the server, see col. 2, lines 19-24 and Fig. 2).

With respect to claim 12,

Chern teaches an Internet system (see col. 1, lines 58-61) comprising:

an Internet web site linking to a map server for receiving a map request for a telephone number sent to said Internet web-site (depending on the display capabilities of the mobile telephone the Web server responses with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20 and col. 2, lines 19-24, Fig. 2); and

said Internet web site comprising a map request processor for enabling a database search (see Fig. 2, element 138) for determining a geographic location associated with said telephone number and retrieving a map for said geographic

location (the Web server marks the location of the mobile telephone device on the map, upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

As to claim 13,

Chern teaches wherein: said map request processor further comprising a database (see Fig. 2, element 138) for associating said telephone number with a geographic location and associating said geographic location with a map (the Web server sends a message to the mobile telephone device requesting the device's location. When the mobile telephone device receives the request, it responds by acquiring Global positioning system location and then sending the location to the server, see col. 2, lines 19-24).

As to claim 14,

Chern teaches wherein: said map request processor further comprising a first database for associating said telephone number with a geographic location and a second database for associating said geographic location with a map (the Web server marks the location of the mobile telephone device on the map, upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

As to claim 16,

Chern teaches wherein: said map request processor further comprising a map request handler for handing said map request submitted in hypertext transfer protocol (HTTP), simple mail transfer protocol (SMTP) and telephonic-tone input as said map

request (the Web server marks the location of the mobile telephone device on the map and upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

As to claim 18,

Chern teaches wherein: said map request processor further comprising an automatic Internet universal resource location (URL) linking processor for linking to several universal resource locations (URLs) for enabling a database search for determining a geographic location associated with said telephone number and for retrieving a map for said geographic location (a mobile telephone device publishes its location to a server computer that is connected to the Word Wide Web ("Web") and the information about the location of the mobile telephone device is available from the Web server. The location of the mobile telephone device can obtained through the Internet, see col. 1, lines 59-65 and col. 7, lines 15-20, Fig. 2).

As to claim 19,

Chern teaches a telephone for sending said map request with a telephone number to said map request processor (the Web server marks the location of the mobile telephone device on the map and upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

As to claim 20,

Chern teaches wherein: said telephone is a wireless telephone for sending said map request (using the browser, the requesting party navigates to and selects an option for retrieving location information. Device then connects to a server connected to Web

via wireless network. The requesting party enters the required authorization information and a unique identifier of the specific mobile telephone device whose location is desired, see col. 7, lines 7-13).

With respect to claim 21,

Chern teaches a network system (see col. 2, lines 63-65) comprising:

a map server for receiving a numeric data input (depending on the display capabilities of the mobile telephone the Web server responses with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20 and col. 2, lines 19-24, Fig. 2);

said map server further includes a database-search (see Fig. 2, element 138) enabling means for enabling a database search for determining a geographic location associated with said numeric input and a map associated with said geographic location (the Web server marks the location of the mobile telephone device on the map and upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

With respect to claim 22,

Chern teaches a network system (see col. 2, lines 63-65) comprising:

a geocentric server for receiving a numeric data input (depending on the display capabilities of the mobile telephone the Web server respond with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20 and col. 2, lines 19-24, Fig. 2);

said geocentric server further includes a database-search (see Fig. 2, element 138) enabling means for enabling a geocentric database search for determining a geographic location associated with said numeric input (the Web server marks the location of the mobile telephone [numeric] device on the map and upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

As to claim 23,

Chern teaches wherein: said geocentric server further includes a geocentric filter means for applying said geographic location associated with said numeric input to establish a geocentric filter for filtering a subsequent database search (filters implemented to refine the request and selections returned. The user set a location filter that requires returned selections be within a certain maximum number of miles of the user's current location. If the user is seeking a restaurant, the user may request or be prompted to select parameters that refine the search results, see col. 5, lines 19-25).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-8, 10, 15, 17, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern et al. ('Chern' hereinafter), US Patent 6,456,854 as applied to claims 1-5, 9, 11-14, 16, and 18-23 above in view of Yacoby et al. ('Yacoby' hereinafter), US Patent 6,516,311 B1.

As to claim 6

Chern teaches wherein: said step a) of sending a map request with a telephone number to said Internet web-site further comprising a step of said Internet web site receiving and telephone number sent with said map request into a telephone number (depending on the display capabilities of the mobile telephone the Web server responses with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20, Fig. 2).

Chern does not explicitly indicate the claimed "normalized telephone number".

Yacoby discloses the claimed normalized telephone number (upon receipt of the formatted (normalized) telephone number the parsing server would executes a PERL substitution command to deformat the telephone number to produce an unformatted telephone number, see col. 5, lines 64-67 and col. 15, lines 47-55, Yacoby).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention, to combined the teachings of the cited references because the normalized telephone number of Yacoby's teachings would have allowed Chern's system to reduce likelihood of an error or failure and multiple telephone numbers being mapped to the same Web site, as suggested by Yacoby at col. 4, lines 3-5. Normalized telephone number as taught by Yacoby improves a fast, efficient and

Art Unit: 2177

simple method to take an Internet user from a telephone number to a Web page and the Web page can be any page at a Web site (see col. 3, lines 67 to col. 4, lines 3).

As to claim 7

Chern teaches wherein: said step a) of sending a map request with a telephone number to said Internet web-site further comprising a step of applying said telephone number for searching an address listed for said telephone number (depending on the display capabilities of the mobile telephone the Web server responses with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20, Fig. 2).

As to claim 8,

Chern teaches wherein: said step b) further comprising a step of retrieving a map of said address listed for said telephone number (a requesting party gain access to a Web server via browser residing on a mobile telephone device. Using the browser, the requesting party navigates to and selects an option for retrieving location information, see col. 7, lines 5-9).

As to claim 10,

Chern teaches wherein: said step a) of sending a map request as a numeric input data comprising a step of sending said map request to said network server with a partial telephone number (depending on the display capabilities of the mobile telephone the Web server responses with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20, Fig. 2).

As to claim 15,

Chern teaches wherein: said map request processor further comprising a telephone number normalization processor for said telephone number sent with said map request into a telephone number for enabling said database search for retrieving a map for said telephone number (depending on the display capabilities of the mobile telephone which Web server respond with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20, Fig. 2).

Chern does not explicitly indicate the claimed "normalized telephone number".

Yacoby discloses the claimed normalized telephone number (upon receipt of the formatted (normalized) telephone number the parsing server would executes a PERL substitution command to deformat the telephone number to produce an unformatted telephone number, see col. 5, lines 64-67 and col. 15, lines 47-55, Yacoby).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention, to combined the teachings of the cited references because the normalized telephone number of Yacoby's teachings would have allowed Chern's system to reduce likelihood of an error or failure and multiple telephone numbers being mapped to the same Web site, as suggested by Yacoby at col. 4, lines 3-5. Normalized telephone number as taught by Yacoby improves a fast, efficient and simple method to take an Internet user from a telephone number to a Web page and the Web page can be any page at a Web site (see col. 3, lines 67 to col. 4, lines 3).

As to claim 17,

Chern teaches wherein: said map request handler further comprising a partial telephone number handler for handing said map request submitted with partial

Art Unit: 2177

telephone number (a requesting party gain access to a Web server via browser residing on a mobile telephone device. Using the browser, the requesting party navigates to and selects an option for retrieving location information, see col. 7, lines 5-9).

Chern does not explicitly indicate the claimed "partial telephone number".

Yacoby discloses the claimed partial telephone number (the Internet user interacts with the web page server where the user's interaction includes at least part of a telephone number and executed a query of the directory database to yield a query result comprising a registrant web site page corresponding to the user interaction, see col. 3, lines 46-52, Yacoby).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention, to combined the teachings of the cited references because the partial telephone number of Yacoby's teachings would have allowed Chern's system to establish a directory database server with a directory database comprised of registrant telephone numbers and associated therewith registrant web pages, as suggested by Yacoby at col. 4, lines 3-5. Partial telephone number as taught by Yacoby improves traffic generated by a telephone number to web page server to build an audience for advertisements on the net (see col. 3, lines 30-31).

As to claim 24,

Chern teaches wherein: said geocentric server is provided for receiving a numeric data input comprising at least a telephone number (depending on the display capabilities of the mobile telephone the Web server responses with street address and

a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20 and col. 2, lines 19-24, Fig. 2); and

said database-search (see Fig. 2, element 138) enabling means is provided for enabling a geocentric database search for determining a geographic location associated with said telephone number (the Web server marks the location of the mobile telephone device on the map, upon receiving the request the Web server delivers the marked map to the requesting party, see col. 7, lines 35-38 et seq.).

Chern does not explicitly indicate the claimed "part of telephone number".

Yacoby discloses the claimed partial telephone number (the Internet user interacts with the web page server where the user's interaction includes at least part of a telephone number and executed a query of the directory database to yield a query result comprising a registrant web site page corresponding to the user interaction, see col. 3, lines 46-52, Yacoby).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention, to combined the teachings of the cited references because the part of telephone number of Yacoby's teachings would have allowed Chern's system to establish a directory database server with a directory database comprised of registrant telephone numbers and associated therewith registrant web pages, as suggested by Yacoby at col. 4, lines 3-5. Part of telephone number as taught by Yacoby improves traffic generated by a telephone number to web page server to build an audience for advertisements on the net (see col. 3, lines 30-31).

As to claim 25,

Chern teaches wherein: said geocentric server further includes a processor for normalizing said numeric data input into a numeric data input (depending on the display capabilities of the mobile telephone the Web server responses with street address and a map with the mobile telephone's location noted on the map, see col. 7, lines 17-20 and col. 2, lines 19-24, Fig. 2).

Chern does not explicitly indicate the claimed "normalized telephone number".

Yacoby discloses the claimed normalized telephone number (upon receipt of the formatted (normalized) telephone number the parsing server would executes a PERL substitution command to deformat the telephone number to produce an unformatted telephone number, see col. 5, lines 64-67 and col. 15, lines 47-55, Yacoby).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention, to combined the teachings of the cited references because the normalized telephone number of Yacoby's teachings would have allowed Chern's system to reduce likelihood of an error or failure and multiple telephone numbers being mapped to the same Web site, as suggested by Yacoby at col. 4, lines 3-5. Normalized telephone number as taught by Yacoby improves a fast, efficient and simple method to take an Internet user from a telephone number to a Web page and the Web page can be any page at a Web site (see col. 3, lines 67 to col. 4, lines 3).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,539,080 B1, issued to Bruce et al (Method and system for providing quick directions): teaches geographic location of the caller can be determined by an automatic location identification system.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (703) 605-4356. The examiner can normally be reached on Monday to Thursday from 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790 or Customer Service (703) 306-5631. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.



Mohammad Ali

Patent Examiner

AU 2177

MA

September 19, 2003